UNITED STATES PATENT AND TRADEMARK OFFICE

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09/477,193	01/04/2000	JAMES R. TIGHE	062891.0292	8822

7590 03/03/2004	EXAMINER
BAKER & BOTTS LLP	COLIN, CARL G
2001 ROSS AVENUE	
DALLAS, TX 752012980	

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>26 November 2003</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-45</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-45</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

   a)☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)   4)☐ Interview Summary (PTO-413) Paper No(s). _____.

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5)☐ Notice of Informal Patent Application (PTO-152)

3)☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u>. 6)☐ Other: .

DETAILED ACTION

Response to Arguments

1.   In response to communications filed on 11/26/2003, applicant amends claims 1-3 and

claims 26-27. The following **claims 1-45** are presented for examination.

2.   The amendments to the specifications on pages 2-3, filed on 11/26/2003, have been

considered.

2.1   Applicant's arguments, pages 18-19, filed on 11/26/2003, with respect to the rejection of

claims 1, 2, and 26, under 35 USC 102 (e) have been fully considered and are persuasive. Fiori

teaches establishing a secure communication, but does not explicitly state that the

communication is between a trusted network and an untrusted device external to the trusted

network. Fiori also fails to disclose the modifying address step to specify the port of the proxy.

Therefore, the rejection has been withdrawn. Regarding claims 3 and 27, the rejection has been

withdrawn for the same reason described above. Fiori discloses intercepting a call in reference

to figure 1 at the network terminal (see also column 6, lines 33-34), but fails to disclose a trusted

network. Regarding claims 11-13, 35-37, and 43-45, the rejection has been withdrawn for the

same reason described above. Regarding claims 22-23 and 39-40, Fiori discloses list of network

addtesses but the rejection has been withdrawn for the same reason described above concerning

trusted and untrusted network. Upon further consideration, a new ground of rejection is made in

view of two new references. Hokari teaches communications between a trusted network and an

untrusted network. Cohen et al. discloses the modifying step of network addresses to specify a

port of a proxy. Regarding the other dependent claims, the teaching of Fiori still applies as far as

disclosing the limitations of the other original dependent claims. A new ground of rejection is

made in view of Fiori under 35 USC 103 (a).

Specification

2.2   The disclosure is objected to because of the following informalities on page 18, line 7:

"24b" should be replaced with --24a--.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another
filed in the United States before the invention thereof by the applicant for patent, or on an
international application by another who has fulfilled the requirements of paragraphs (1),
(2), and (4) of section 371(c) of this title before the invention thereof by the applicant for
patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999

(AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002

do not apply when the reference is a U.S. patent resulting directly or indirectly from an

international application filed before November 29, 2000. Therefore, the prior art date of the

reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA

35 U.S.C. 102(e)).

3.1   **Claims 14-16** are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent

5,455,855 to **Hokari**.

3.2   **As per claim 14, Hokari** discloses a communication network for establishing a

telephone call between a trusted telephone and an untrusted device, the communication network

comprising: a first trusted network; a trusted telephone coupled to the first trusted network (see

abstract); a PBX 102 that meets the recitation of an authentication controller coupled to the first

trusted network and operable to evaluate a call initiation request received from an untrusted

device external to the first trusted network (column 4, lines 13-16); and a PBX 103 that meets the

recitation of a call manager operable to initiate the creation of a telecommunication link between

the trusted telephone and the untrusted device in response to a positive evaluation of the call

initiation request (column 4, lines 13-59).

As per claim 15, **Hokari** discloses the limitation of wherein the call manager is further

operable to initiate the creation of a telecommunication link between the untrusted device and the

trusted telephone comprises establishing a telecommunication link using PBX 103 that meets the

recitation of a telephony proxy whereby all telecommunications between the trusted telephone

and the untrusted device are communicated through the telephony proxy (see figure 1).

Claim 16 recites the same limitation as claim 14 implemented in software and is rejected on the same rationale as the rejection of claim 14.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4.1   **Claim 1** is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,455,855 to **Hokari** in view of US Patent 6,584,562 to **Fiori** and in view of US Patent 6,389,462 to **Cohen et al.**.

4.2   **As per claim 1, Hokari** substantially teaches a method for establishing a telephone call between a trusted Internet Protocol (IP) telephone and an untrusted device (abstract); the method comprising, receiving a call initiation request from an untrusted device external to a trusted network, indicating a desired communication with a trusted IP telephone coupled to the trusted network (column 4, lines 13-16); evaluating the call request and establishing a

telecommunication link between the untrusted device and the trusted IP telephone in response to

a positive evaluation of the call initiation request (column 4, lines 13-59); associating a first

logical port with the trusted device and a second port logical port with the untrusted device (see

figure 3); receiving first telecommunication data from the untrusted device at the first logical

port (see column 4, lines 13-15). receiving second telecommunication data from the trusted

device (see column 5, lines15-17). **Hokari** does not explicitly state that the trusted device is an

IP telephone. It is known in the art that the trusted subscriber could be a trusted IP telephone.

Fiori in an analogous art discloses a similar design wherein the subscriber is an IP telephone (see

abstract). Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify the method of **Hokari** to provide a subscriber as an IP telephone

as taught by **Fiori** to connect the subscribers to an Internet connection (see column 1, lines 13-

47). This modification would have been obvious because one skilled in the art would have been

motivated by the suggestions provided by **Fiori** so as to connect the subscribers to the Internet.

     Hokari further discloses the step of modifying the sub-address information to specify the

ISDN numbers assigned to the PBXs (see column 4, line 33 through column 5, line 35). To one

skilled in the art the ISDN numbers meet the recitation of the ports of the proxy. However,

Cohen et al. in an analogous art discloses modifying a first source address information to specify

the second logical port of the telephone proxy and communicating the data with the modified

first source address information to the server (see column 8, lines 28-37); modifying a second

source address in the second telecommunication data to specify the first logical port of the

telephone proxy and communicating the data with the modified second source address

information to the client (see column 8, lines 37-49). Therefore, it would have been obvious to

one of ordinary skill in the art at the time the invention was made to modify the method of

Hokari to provide the step of modifying a first source address information to specify the second

logical port of the telephone proxy and communicating the data with the modified first source

address information to the trusted device and reverse it to communicate with the untrusted device

as taught by **Cohen et al.** to establish a transparent connection between the trusted device and

the untrusted device. This modification would have been obvious because one skilled in the art

would have been motivated by the suggestions provided by **Cohen et al.** so as to establish a

transparent connection between the trusted device and the untrusted device.

5.   **Claims 2-10, 17-20, 22-34, and 38-42** are rejected under 35 U.S.C. 103(a) as being

unpatentable over US Patent 5,455,855 to **Hokari** in view of US Patent 6,584,562 to **Fiori**.

5.1   **As per claim 2, Hokari** substantially teaches a method for establishing a telephone call

between a trusted Internet Protocol (IP) telephone and an untrusted device (abstract); the method

comprising, receiving a call initiation request from an untrusted device external to a trusted

network, indicating a desired communication with a trusted IP telephone coupled to the trusted

network (column 4, lines 13-16); evaluating the call request and establishing a

telecommunication link between the untrusted device and the trusted IP telephone in response to

a positive evaluation of the call initiation request (column 4, lines 13-59). **Hokari** does not

explicitly state that the trusted device is an IP telephone. It is known in the art that the trusted

subscriber could be a trusted IP telephone. **Fiori** in an analogous art discloses a similar design

wherein the subscriber is an IP telephone (see abstract). Therefore, it would have been obvious

to one of ordinary skill in the art at the time the invention was made to modify the method of

Hokari to provide a subscriber as an IP telephone as taught by **Fiori** to connect the subscribers

to an Internet connection (see column 1, lines 13-47). This modification would have been

obvious because one skilled in the art would have been motivated by the suggestions provided by

Fiori so as to connect the subscribers to the Internet.

As per claim 3, Hokari discloses the limitation of wherein receiving a call initiation

request from the untrusted device comprises intercepting a call initiation request at an entry point

to the trusted network servicing the trusted IP telephone, the call initiation request sent from

outside the trusted network by the untrusted device (see column 4, lines 13-16 and column 4,

lines 38-43).

As per claim 4, Hokari discloses the limitation of wherein evaluating the call initiation

request comprises determining whether the trusted IP telephone is a proper recipient of a

telephone call from an untrusted device (see column 4, lines 13-37 and column 2, lines 48-53).

As per claims 5-6, Hokari discloses the limitation of wherein determining whether the

trusted IP telephone is a proper recipient of a telephone call from an untrusted device comprises

determining whether a network address of the trusted IP telephone is included in a list of

approved network addresses and whether a network address of the untrusted device is included in

a list of approved network addresses (see column 2, lines 48-53). It is obvious that the

identification numbers referred to herein can be in form of network addresses in an internet

connection as in figure 1 of Fiori.

As per claim 7, both references substantially disclose the claimed method of claim 2.

Hokari discloses communication exchange. **Hokari** does not explicitly disclose which type of

communication such as media streaming. It is well known in the art that the invention of **Hokari**

is capable of implementing media streaming. **Fiori** in an analogous art discloses wherein

evaluating the call initiation request comprises determining the untrusted device is requesting the

establishment of media streaming with the trusted IP telephone (column 3, lines 31-67 see also

column 4, lines 45 et seq.). Therefore, it would have been obvious to one of ordinary skill in the

art at the time the invention was made to modify the method of **Hokari** to implement media

streaming as taught by **Fiori** to exchange communications and file transfer.

As per claim 8, Hokari discloses the limitation of wherein establishing a

telecommunication link between the untrusted device and the trusted IP telephone comprises

establishing a telecommunication link using PBX 103 that meets the recitation of a telephony

proxy whereby all telecommunications between the trusted IP telephone and the untrusted device

are communicated through the telephony proxy (see figure 1).

As per claims 9-10, Fiori discloses way of determining the type of data transmitting by

the subscribers that meets the recitation of monitoring the telecommunication link to determine

whether the telecommunications being sent by the untrusted device use an appropriate audio

format and media streaming (column 3, lines 31-67 see also column 4, lines 45 et seq.).

As per claims 17-20, **Hokari** substantially teaches the claimed network of claim 14.
Hokari does not explicitly state that the trusted device is an IP telephone and the ISDN network
is coupled to the Internet and a PSTN using a gateway. **Fiori** in an analogous art discloses an
ISDN network coupled to the Internet and a PSTN using a gateway (see abstract). To one
skilled in the art, it is apparent that the invention of Hokari can be coupled to the Internet.
Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention
was made to modify the method of **Hokari** to provide a subscriber as an IP telephone and
coupled to the Internet and the PSTN using a gateway as taught by **Fiori** to connect the
subscribers to an Internet connection (see column 1, lines 13-47 and figure 1). This modification
would have been obvious because one skilled in the art would have been motivated by the
suggestions provided by **Fiori** so as to connect the subscribers to the Internet.

Claims 22 and 23 recite the same limitation as claims 5-6 wherein the authentication
controller comprises list of addresses of network devices permitted to receive telephone calls
from the untrusted and list of network addresses permitted to communicate with the trusted
telephone (column 2, lines 48-53 and columns 4-5). It is obvious that the identification numbers
referred to herein can be in form of network addresses in an internet connection as in figure 1 of
Fiori.

Claims 24-25 recite the same limitations as claims 9-10 and are rejected on the same
rationale as the rejection of claims 9-10.

Claims **26-34** recite the same limitations as claims 2-10 respectively by referring to a software instead of a method and are rejected on the same rationale as the rejection of claims 2-10.

Claim **38** recites the same limitations found in claims 14-15 with respect to IP telephone in claim 2 and are rejected on the same rationale as the rejection of claim 2 with the citations of claims 14 and 15.

Claims **39-42** recite the same limitations as claims 22-25 respectively by referring to an apparatus instead of a network and are rejected on the same rationale as the rejection of claims 22-25.

6.   **Claim 21** is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,455,855 to **Hokari**.

6.1   **As per claim 21,** the additional trusted network is a design choice and does not depart from the spirit and scope of the invention of **Hokari**, which is not limited to one network. To a person having ordinary skill in the art, it is obvious that the communication network described by **Hokari** may comprise a second trusted network.

7.   **Claims 11-13, 35-37, and 43-45** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,455,855 to **Hokari** in view of US Patent 6,584,562 to **Fiori** and further in view of US Patent 6,389,462 to **Cohen et al.**.

7.1   **As per claim 11,** both references substantially teach the claimed method of claim 8.

Neither of the references explicitly teaches the modifying step as recited in claim 11. **Cohen et**

al. in an analogous art teaches modifying source address information in the received

telecommunication data to specify a second logical port of the telephone proxy associated with

the untrusted device and communicating the data with the modified source address information

to the trusted IP telephone (see column 8, lines 28-37 and lines 37-49).   Therefore, it would have

been obvious to one of ordinary skill in the art at the time the invention was made to modify the

method as combined above to provide the step of modifying source address information in the

received telecommunication data to specify a second logical port of the telephone proxy

associated with the untrusted device and communicating the data with the modified source

address information to the trusted IP telephone as taught by **Cohen et al.** to establish a

transparent connection between the trusted device and the untrusted device. This modification

would have been obvious because one skilled in the art would have been motivated by the

suggestions provided by **Cohen et al.** so as to establish a transparent connection between the

trusted device and the untrusted device.

         As per claim 12, Fiori discloses the limitation of wherein associating a first logical port

of the telephony proxy with the untrusted device comprises associating a User Datagram

Protocol (UDP) logical port to enable the streaming of IP packets (column 3, lines 1-6).   To a

person having ordinary skill in the art, **Fiori** discloses a system capable of exchanging

information using UDP (see also column 4, lines 45 et seq. and column 8, lines 1-36).

As per claim 13, **Cohen et al.** discloses the limitation of wherein modifying the source address information in the received telecommunication data comprises modifying a source IP address and a source port in a header of each IP packet (see column 8, lines 28-37 and lines 37-49).

Claims 35-37 recite the same limitations as claims 11-13 respectively by referring to a software instead of a method and are rejected on the same rationale as the rejection of claims 11-13.

As per claim 43, claim 43 recites some of the limitations found in claim 11 and is rejected on the same rationale as the rejection of claim 11.

As per claim 44, **Fiori** discloses the limitation of wherein the first and second logical ports are User Datagram Protocol (UDP) logical ports (column 3, lines 1-6). To a person having ordinary skill in the art, **Fiori** discloses a system capable of exchanging information using UDP (see also column 4, lines 45 et seq. and column 8, lines 1-36).

As per claim 45, **Cohen et al.** discloses the limitation of wherein modifying the source address information in the received telecommunication data comprises modifying a source IP address and a source port in a header of each IP packet (see column 8, lines 28-37 and lines 37-49).

Conclusion

8.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
        a. US Patent 6,363,411   Dugan et al.

This patent pertains to an intelligent telecommunications switching network. Many of

the claimed features, i.e. list of network addresses permitted or denied access between trusted

and untrusted, media streaming, ISDN coupled to the Internet, etc. are disclosed in this reference.

8.1   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Carl Colin whose telephone number is 703-305-0355. The

examiner can normally be reached on Monday through Thursday and every other Friday, 8:00-

6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Ayaz Sheikh can be reached on 703-305-9648. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is 703-305-3900.

ce

Carl Colin

Patent Examiner

February 24, 2004

AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100